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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,389	12/10/2001	Jean-Noel Thorel	108961.01	8418

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EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/006,389

Applicant(s)

THOREL, JEAN-NOEL

Examiner

Susan Coe

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/341,900.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. The amendment filed December 2, 2002 has been received and entered.
2. Claims 21 and 22 have been added.
3. Claims 1-22 are currently pending.

***Election/Restrictions***

4. Applicant's election with traverse of Group I, claims 1-16, 21, and 22, amino acid for at least one of the biodermal constituent and trace elements for the non-biodermal constituent in Paper No. 6, dated December 2, 2002 is acknowledged. The traversal is on the ground(s) that a search of group one would encompass a search of the additional groups. This is not found persuasive because while a search of all of the groups would overlap to some extent, it would not necessarily be coextensive. Applicant's also argue against the election of species requirement for the non-biodermal constituent. Applicant argues that the non-biodermal constituent is not an essential aspect of the invention. However, applicant's claims are of such broad scope that an election of species requirement is necessary in order to have a starting place for a search. Therefore, the election of species requirement is considered valid.

The requirement is still deemed proper and is therefore made FINAL.

5. Claims 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.
6. Claims 1-16, 21, and 22 are examined on the merits.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-16, 21, and 22 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,342,236. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is an overlap in scope between the patented claims and the pending claims. The pending claims are of a broad scope that encompasses the claim of US '236. The claim of US '236 contains a composition that meets the limitations of applicants claims. Therefore, the claims are not considered patentably distinct.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, 14, 15, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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8. Claim 4 is indefinite because it is not clear how to determine the weight of the biodermal constituent of the skin. To determine the total weight of one component found in the skin of an entire person would be extremely difficult, and applicant does not provide guidance that would allow a person of ordinary skill in the art to make a definite determination of the weight of the biodermal constituent as it occurs naturally in the skin.

9. Claim 5 is indefinite because it is not clear what values are encompassed by "major portion" and "minor portion."

10. Claim 14 is indefinite because the language of the claim is very confusing. There are two negative limitations and it is not clear how these limitations relate to each other.

11. Claim 15 is indefinite because it is not clear if the claim means that the excipient or vehicle itself cannot contain water or if water is an example of the excipient or vehicle.

12. Claim 16 is indefinite because it is not clear how "similar" the macromolecular components can be to the skin constituent to be encompassed by this limitation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-8, 12, 14-16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 89/05629.

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WO '629 teaches a cosmetic composition that can contain 60 to 100% amino acids, 10 to 20% vitamin E, and 0.5 to 2% fatty acids. All of these components are considered biodermal constituents. The cosmetic can also contain varying amount of albumin, 1 to 3% animal hormone or 0.5 to 2% of a polyol. These are considered non-biodermal constituents.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 9-13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 89/05629 and US Pat. No. 4,863,897.

As discussed above WO '629 teaches a composition that contains 60 to 100% amino acids, 10 to 20% vitamin E, and 0.5 to 2% fatty acids. The cosmetic can also contain varying amount of albumin, 1 to 3% animal hormone or 0.5 to 2% of a polyol. However, the reference does not specifically teach adding water or trace elements to the composition. US '897 teaches using water and trace elements in cosmetic compositions. The trace elements are included in amounts under 2% (see claims). Based on the teaching by US '897 that water and trace elements are used in cosmetic compositions, a person of ordinary skill in the art would reasonably expect that adding these ingredients to the composition of WO '629 would be beneficial because all of the ingredients are known to have cosmetic effects on the skin. Therefore, an artisan of ordinary

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skill would have been motivated to add trace elements and water to the composition of WO '629 based on the teaching by US '897.

The references teach combining the claimed elements together; however, they do not specifically teach formulating the cosmetic in two-phase dispersions claimed by applicant. These two-phase forms are well known in the art to be desirable formulations for cosmetics; therefore, a person of ordinary skill in the art would have been motivated to formulate the composition taught by the references in these forms.

15. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner  
December 24, 2002



LEON B. LANKFORD, JR.  
PRIMARY EXAMINER